

REMARKS

Claims 1-10, 13-16, 26, and 35-39 are pending in the application. Claims 1-10, 35, 36, and 38 have been allowed. Claims 13-16 and 37 have been rejected and claims 26 and 39 have been objected to.

Claim 13 has been amended as discussed below. Claims 5, 6, 8, and 15 have been amended to clarify language. No new matter is believed to have been added by the amendments.

35 U.S.C. § 102(a)

Claims 13-16 and 37 have been rejected as allegedly anticipated by Parchi et al. (1996, Am. Neurol. Assoc., 39:767-778). Applicant respectfully disagrees with the rejection.

M.P.E.P. 2131 states

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). . . . “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim . . .

Applicant maintains that Parchi et al. does not meet the criteria for anticipating the claimed invention.

The Office Action states

Applicants argue that the reference relates only to CJD and does not show the specific banding pattern resulting from bovine spongiform encephalopathy. This is not convincing because instant claim 13 states a method of identifying infection in an animal and/or tissue of bovine spongiform encephalopathy. The word “or” mean [sic] that it is not required.

Applicant believes that this reading of claim 13 would not be made by one in the art. However, to clarify the claim, the language has been amended to “[a] method of identifying a bovine spongiform encephalopathy...” The term “of bovine spongiform encephalopathy” that followed “infection in an animal and/or tissue” has been deleted. Applicant believes that the amendment clarifies this aspect of the rejection and, as previously discussed, Applicant maintains that the reference relates only to CJD and not bovine spongiform encephalopathy.

The Office Action also states

Additionally said claim [claim 13] is stating that said prion protein can be characterized by having three distinct bands. The term “can be” means having the capability which is not the same as actually performing the function.

The Office Action characterizes Parchi et al. as disclosing

distribution of protease-resistant prion protein with Western blot and immunohistochemistry in cases of sporadic Creutzfeldt-Jacob disease,” and as identifying groups of subjects that were defined by genotype...and two types of proteases-resistant proteins that differed in size and glycosylation” (Office Action at page 2, item 3).

The Office Action also states “two types of PrP type 1 and 2 were detected and differed in electrophoretic mobility and ratio of the differently glycosylated PrP isoforms.” (Office Action, page 2-page 3, item 3).

Claim 13 has been amended to specify that “the prion protein is characterized by...” the defined glycoform ratios. As stated in the Office Action, a method defined by the amended claim requires the step of identifying a prion protein type having the defined glycoform ratios to be actually performed. Parchi et al. does not disclose identifying a protein type having the defined glycoforms.

Furthermore, Applicant maintains that Parchi et al. is limited to the description of two types of prion protein (see Figure 1 and Table 1 of Parchi et al.), both of which have three glycoforms, the high molecular weight glycoform, the low molecular weight

glycoform and the unglycated form. For purposes of this Reply, the high molecular weight glycoform is referred to as “H,” the low molecular weight glycoform as “L,” and the unglycated form as “U.”

Claim 13 is drawn to a method in which the characterized prion protein type has the highest abundance of the H glycoform, the lowest abundance of the U glycoform, and the abundance of the L glycoform falls between the abundances of the H and U glycoforms. This is different from the relative abundances of the glycoforms disclosed in Parchi et al., in which the relative abundance of the L glycoform is greater than for either the H or U forms. This is illustrated in Appendix A (attached), which is a graph comparing the specific glycoform ratios (i.e., relative abundances) of the two types of prion protein disclosed in Table 1 of Parchi et al. to the glycoform ratio described in pending claim 13. As is apparent from the graph, the relative abundances of the forms are different between claim 13 and Parchi et al., and a prion protein of the type specified by claim 13 is not disclosed in Parchi et al. Accordingly, Parchi et al. does not disclose the claimed features of the invention and therefore cannot anticipate the claimed invention.

Accordingly, Applicant maintains that, as amended, claim 13 is not anticipated by Parchi et al. and requests that the rejection of claim 13 under 35 U.S.C. §102 be withdrawn

Claims 14-16 and 37

The remaining rejected claims (14-16 and 37) depend from claim 13. No rejection independent of the rejection of claim 13 was articulated for these claims in the Office Action. As discussed above, claim 13 is believed to be allowable and therefore the claims that depend from claim 13 are also believed to be in condition for allowance. Accordingly, Applicant requests that the rejection of claims 14-16 and 37 be withdrawn.

Objections

Claims 26 and 39 have been objected to as dependent on a claim that is not allowable. Claim 26 depends from claim 13 and claim 39 depends from claim 16. Both claims 13 and 16 are discussed above and, in view of the claim amendment to claim 13 and the arguments presented above, are believed to be allowable. Applicant therefore submits that it is not necessary to rewrite claims 26 and 39 since they are believed to depend from allowable claims. Accordingly, applicant requests that the objection to claims 26 and 39 be withdrawn.

CONCLUSION

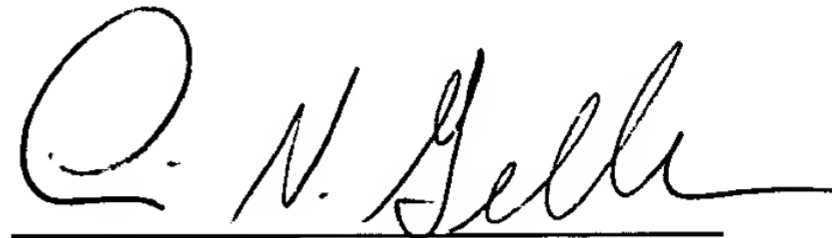
Applicant believes that, in view of the amendments and arguments presented herein, all of the claims are in condition for allowance, which action is respectfully requested.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue, or comment does not signify agreement with, or concession of, that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

If the Examiner believes that a telephone conference will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

No fees are believed to be due in connection with this submission. However, please charge any fees that might be due or credit any overpayment to our Deposit Account No. 08-0219, referencing Attorney Docket No. 102286.408CON.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "L. N. Geller", written over a horizontal line.

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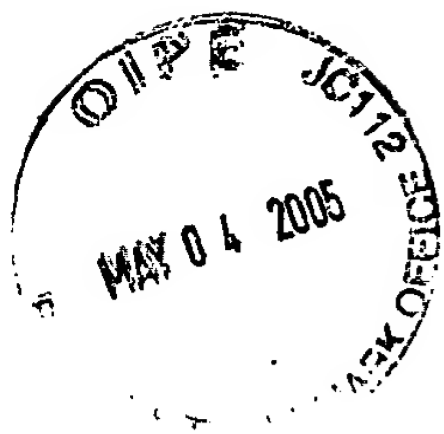
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Appendix A

